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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,416	07/29/2003	Steven P. McGahn	112300-1666	5965

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BELL, BOYD & LLOYD LLC
P. O. BOX 1135
CHICAGO, IL 60690-1135

EXAMINER	
ASHBURN, STEVEN L	
ART UNIT	**PAPER NUMBER**
3714	

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/629,416	MCGAHN ET AL.	
	Examiner	Art Unit	
	Steven Ashburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-74* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-74* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 July 2003* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/29/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-46 and 48-73 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,659,864 in view of Menke, DE 3811301-A1 (Oct. 19, 1989).

The '864 patent claims all the features of the listed claims except employing the moveable member to selectively mask a secondary game display upon the occurrence of a trigger event and displaying a direction indicator to direct a player to the secondary display. Regardless, at the time of the invention, secondary games were widely used the gaming art to increase usage gaming machines by providing more complex games offering the potential of larger payoffs. Menke discloses a gaming device having a secondary game display with masked award indicia wherein the indicia are unmasked upon the

occurrence of a triggering event and an indication (15) is provided to direct a player to the secondary display. *See fig. 1-6.* Thus, in view of Menke, it would have been obvious to an artisan at the time of the invention to modify the device claimed in the '864 patent, wherein a movable member conceals award indicia, to add the feature of employing the moveable member to selectively mask a secondary game display upon the occurrence of a trigger event and displaying a direction indicator to direct a player to the secondary display. As suggested by the prior art, the modification would result in more interesting and complex game that would be more attractive to players and thereby generate greater revenues for operators.

Claims 47 and 48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,659,864 in view of Menke, as applied to claim 44 above, in further view of Minoru, JP 08-173591 (Sep. 7, 1996).

Claim 47. The gaming device suggested by the '864 patent in view of Menke describes all the features of the claims except a first sensing device and a second sensing device, wherein the first sensing device is operable to send a signal to the processor to cause said processor to stop the first motor from sliding the first member, and the second sensing device is operable to send a signal to the processor to causes said processor to stop the second motor from sliding the second member. Minoru discloses a gaming device that sensing device operable to send a signal to a processor to cause it to stop a motor from closing a shutter over a gaming display to preserve unused outcomes and increase the reliability of the opening and closing of the shutter. *See fig. 4; ¶¶ 13, 17, 18, 20.* In view of Minoru, it would have been obvious to modify the gaming device suggested by the '864 patent in view of Menke, wherein shutters conceal multiple displays, to add the feature of a first sensing device and a second sensing device, wherein the first sensing device is operable to send a signal to the processor to cause said processor to stop the first motor from sliding the first member, and the second sensing device is operable to send a

signal to the processor to causes said processor to stop the second motor from sliding the second member. As suggested by Minoru, the modification would enhance the device by preserving unused outcomes and increasing the reliability of the shutters.

Claim 48. Minoru discloses a pair of optical switches which are positioned to detect when said second display is revealed. *See fig. 4.*

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 17-24, 32-35, 43, 57-61 and 72-74 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Menke, DE 3811301-A1 (Oct. 19, 1989).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 11-16, 26-31, 37-42, 44-46, 49-56, and 62-71 rejected under 35 U.S.C. 103(a) as being unpatentable over Menke in view of Groetchen, U.S. 1,978,395 (Oct. 23, 1934).

Claims 11, 12, 26, 27, 37, 38, 44, 62, 65, 66 and 68. Menke discloses all the features of the claim except slidable members masking mechanical reels. Groetchen discloses an analogous game device using

slidable shutters to mask award indicia included on mechanical reels. *See fig. 1-3; p. 2:22-53.* In view of Groetchen, it would have been obvious to an artisan at the time of the invention to modify the gaming device disclosed by Menke, wherein flip cards conceal award indicia, to substitute the mechanical reels concealed by shutters as described in Groetchen because the prior art demonstrates that the two are equivalents known in the art of gaming for the same purpose of concealing random award indicia in games of chance.

Claims 13-16, 28-31, 39-42, 52, 53, 55, 56, 63, 64 and 69-71. Groetchen discloses rotatable wheels displaying award indicia. *See fig. 1(23), 4(23).* A rotatable wheels constitutes a movable roller and movable wheel.

Claims 45 and 46. Menke discloses a plurality of award indicia (13) from which a processor is operable to select one of said symbols and cause said symbol to be displayed by second display after said directional indicator (15) directs the player to said second display. *See fig. 6.*

Claim 49. Menke discloses a first member and second member are formed of a non-transparent material. *See fig. 1.*

Claims 50 and 51. The combination of Menke with Groetchen describes a triggering event, a processor is operable to cause the first and second motor to respectively slide first member and second members to reveal the second display upon the occurrence of the triggering event. In particular, Menke advances the concealed displays as triggered by either button or computer control. Additionally, Groetchen triggers the sliding of shutters upon the event that the game is over. *See p. 2:70.*

Claim 54 and 67. Menke discloses a speaker which the processor is operable to cause to generate a sound effect when the said first member and said second member reveal said second display. *See abstract.*

Claims 10, 25 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menke in view of Groetchen, as applied to claims 1, 18 and 36 above, in further view of Krise et al, U.S. 5,788,230 (Aug. 4, 1998).

The gaming device suggested by Menke in view of Groetchen describes all the features of the claims except secondary display is selected from the group consisting of: a video monitor, a television screen, a dot matrix display, a cathode ray tube, a light emitting diode, a liquid crystal display, and a electro-luminescent display. Krise teaches that it is known in the art to employ video displays rather than mechanical displays in gamine machine because mechanical displays have higher mechanical maintenance costs than machines with video display. *See col. 1:37-44.* Thus, it would have been obvious to a gaming artisan at the time of the invention to the gaming device suggested by Menke in view of Groetchen to replace the mechanical displays with video displays in order to reduce the maintenance cost of the device. Video monitors, a television screen, dot matrix display, a cathode ray tube, a light emitting diode, a liquid crystal display, and a electro-luminescent display are all equivalent video displays known in the art for the purpose of providing non-mechanical displays in gaming machines.

Claims 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menke in view of Groetchen, as applied to claim 44 above, in further view of Minoru, JP 08-173591 (Sep. 7, 1996).

Claim 47. The gaming device suggested by Menke in view of Groetchen describes all the features of the claims except a first sensing device and a second sensing device, wherein the first sensing device is operable to send a signal to the processor to cause said processor to stop the first motor from sliding the first member, and the second sensing device is operable to send a signal to the processor to causes said processor to stop the second motor from sliding the second member. Minoru discloses a gaming device that sensing device operable to send a signal to a processor to cause it to stop a motor from closing a shutter over a gaming display to preserve unused outcomes and increase the reliability of the opening and closing of the shutter. *See fig. 4; ¶¶ 13, 17, 18, 20.* In view of Minoru, it would have been obvious to modify the gaming device suggested by Menke in view of Groetchen, wherein shutters conceal multiple displays, to add the feature of a first sensing device and a second sensing device, wherein the first sensing device is operable to send a signal to the processor to cause said processor to stop the first motor from sliding the first member, and the second sensing device is operable to send a signal to the processor to causes said processor to stop the second motor from sliding the second member. As suggested by Minoru, the modification would enhance the device by preserving unused outcomes and increasing the reliability of the shutters.

Claim 48. Minoru discloses a pair of optical switches which are positioned to detect when said second display is revealed. *See fig. 4.*

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are

unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.

MARK SAGER
PRIMARY EXAMINER